

### **REMARKS**

Claims 1-29 are all the claims pending in the application, claims 18-22 and 24-28 having been withdrawn from consideration responsive to an election of species requirement. Claims 1, 18, 23, 24, and 29 are the only independent claims. Supporting for the foregoing amendments may be found in, for example, at least para. 0055 and 0066 of the patent publication of the present application.

As an initial matter, Applicant notes with appreciation that the IDS papers filed on April 11, 2005, have been signed and acknowledged by the Examiner.

Claims 1-16 and 23 stand rejected under 35 U.S.C. § 101. Claims 10 and 15 stand rejected under 35 U.S.C. § 112, second paragraph. Claim 17 stands rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 9-17 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0203901 to Wilson et al. Claims 2-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of U.S. Patent No. 7,139,722 to Perrella et al. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson and Perrella, and further in view of U.S. Patent No. 6,937,853 to Hall. Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson and Perrella, and further in view of U.S. Patent No. 7,181,410 to Jones et al. Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

### **Affirmation of Election of Species**

Applicant confirms the election of species 1, claims 1-17, 23, and 29 during a telephonic conference with the Examiner on June 19, 2008.

### **Objection to the Title**

The Examiner has objected to the Title as being not descriptive. The forgoing replacement Title is believed fully responsive to this objection.

**Claim Rejections - 35 U.S.C. §101**

Claims 1-16 and 23 stand rejected under 35 U.S.C. § 101.

Applicant has reviewed the Office Action and notes with appreciation the Examiner's analysis with regard to this rejection. However, Applicant respectfully disagrees with the points set forth in the Action for the following reasons.

As an initial point, Applicant notes that the Examiner's position appears to be that in order to comply with 35 U.S.C. § 101, a claim must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Applicant respectfully disagrees with the Examiner's characterization of the USPTO Interim Guidelines ("Guidelines") on this matter. It appears that the Examiner is addressing the so-called "tangible result" element of the Guidelines. However, this element is but one of several elements that must be considered when assessing statutory subject matter with regard to Section 101.

Applicant will demonstrate that the rejected claims do indeed comply with the Section 101 requirements as being directed to statutory subject matter in just a moment. But first, Applicant first addresses the Examiner's contention that claim 1 recites "purely mental steps." Applicant disagrees with the points raised in the Office Action since this claim recites various features which are not purely mental. For instance, claim 1 recites "detecting a plurality of participants." These participants are not mental, but rather are entities which exist outside one's mental thoughts, to the extent that the participants can be detected in accordance with the claim. Moreover, the claim requires "detecting a location of each of the plurality of participants." The participants must have a location in order to be detected in accordance with the claim; the participants do not simply exist as mere mental thoughts.

Applicant further emphasizes that just because one can mentally perform aspects of the claim does not somehow make the claim recite "purely mental steps." Some or all of the steps recited in claim 1 may be performed using assorted types of devices or systems, for example. Applicant could establish further examples, but the point is that claim 1 clearly does not recite "purely mental steps" as alleged in the Office Action.

Turning now to the Guidelines, Applicant first submits that claim 1 recites a method, which is process that falls within one of the four enumerated categories of patentable subject matter recited in Section 101. (MPEP 2106, IV.C). Applicant recognizes that claims reciting a process and that are directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection. It appears that the “mental steps” referred to in the Office Action refers to this position.

It is generally understood that while abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of Section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, and not for the abstract idea, natural phenomenon, or law of nature itself. (MPEP 2106, IV.C).

Applicant will now establish compliance of claim 1 with Section 101 in view of the Guidelines established by the USPTO and as set forth in MPEP 2106. The Guidelines state that to satisfy Section 101 requirements, the claim must be for a practical application of a Section 101 judicial exception, which can be identified in various ways:

- (1) the claimed invention “transforms” an article or physical object to a different state or thing, or
- (2) the claimed invention otherwise produces a useful, concrete and tangible result.

Applicant submits that claim 1 invention meets the second requirement to the extent that it produces a useful, concrete and tangible result.

### **Claimed invention produces a useful, concrete and tangible result**

In determining whether a claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible and concrete.” (MPEP 2106, IV.C.2). Each of these elements will now be addressed.

#### **“Useful Result”**

For an invention to be “useful” it must satisfy the utility requirement of section 101. The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP 2107. In the present application, there is no question that utility exists. Claim 1 is directed to a method which results in selecting a meeting location, which quite clearly meets this element

#### **“Tangible Result”**

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus, or must operate to change articles or materials to a different state or thing. (MPEP 2106, IV.C.2.2a) In a process claim, for example, the claim must set forth a practical application of a Section 101 judicial exception to produce a real-world result. “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” *Diamond v. Diehr*, 450 U.S. 175, 187, 209 USPQ 1, 8 (1981); see also *Corning v. Burden*, 56 U.S. (15 How.) 252, 268, 14 L.Ed. 683 (1854) (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”).

In the present matter, claim 1 recites “selecting a meeting location.” This is most definitely a real-world result to the extent a meeting location is selected in accordance with the claim. Thus, the tangible result element has been met.

### **“Concrete Result”**

Another consideration is whether the claimed invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. (MPEP 2106, IV.C.2.2c). In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under Section 101).

In the present application, claim 1 recites a series of operations. Applicant submits that one practicing the invention recited therein will be able to repeatedly select a meeting location by following the various operations recited in the claim. No undue experimentation is necessary. Given the same or similar plurality of participants, as well as the same or similar parameters and locations recited in the claim, the various operations of this claim will substantially produce the same selected meeting location. The results of the claim are therefore reproducible, thus satisfying the concrete result element.

### **Summary: Section 101 rejection**

Applicant has demonstrated that claim 1 includes a “practical application” since the final result achieved by this claim (e.g., selecting a meeting location) is “useful, tangible and concrete.” If a claim is directed to a practical application of a Section 101 judicial exception and produces a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. (MPEP 2106., IV). Since claim 1 meets the practical application requirement, this claim is directed toward statutory subject matter in accordance with Section 101.

Independent claims 23 contains language similar to claim 1, and therefore this claim is also believed to be directed toward statutory subject matter for reasons similar to those presented above in conjunction with claim 1. Dependent claims 2-16 are also patentable at least by virtue of their dependence upon claim 1.

**Claim Rejections - 35 U.S.C. §112**

Claims 10 and 15 stand rejected under 35 U.S.C. § 112, second paragraph. The foregoing amendments to these claims are believed to be fully responsive to the points raised in the Office Action.

Claim 17 stands rejected under 35 U.S.C. § 112, first paragraph. The position of the Office Action appears to be that it is improper for a claim to only include elements in means-plus-function (MPF) format. Assuming *arguendo* that claim 17 recites elements in MPF format, Applicant disagrees.

MPEP 2164.08(a) provides “A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph.” This portion of the MPEP addresses the situation where a claim includes only a single element, and that this single element is in MPF format. The *In re Hyatt* case referred to by MPEP 2164.08(a) specifically addresses a claim drawn to only a single element (and not drawn to a combination). (*In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983)). This is not the case in claim 17, which recites three elements as a properly formed combination claim. Whether some or all of the elements of claim 17 are in MPF format is in material. The point is that MPEP 2164.08(a) prohibits claims with only one element as being written in MPF format. MPEP 2164.08(a) therefore does not apply to the three element combination claim 17, and thus, this claim complies with the requirements of 35 U.S.C. § 112, first paragraph.

In view of the forgoing, withdrawal of the stated rejections to claims 10, 15, and 17 is believed proper and is respectfully requested.

**Claim Rejections - 35 U.S.C. §103**

Claims 1, 9-17 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson.

**Insufficient rationale under MPEP 2143**

Claim 1 is directed toward a method which recites “identifying a plurality of possible meeting locations based on a parameter.” Page 8 of the Office Action indicated that Wilson does not teach this element, but then goes on to refer to the point of interest (POI) category types of paras. 0092 and 0093 of that reference for support for the rejection. The Action also states the following:

“The simple substitution of a known element, point of interest category type, in place of another to produce a predictable result, identifying a plurality of possible meeting locations, would have been within the expertise of one of ordinary skill in the art at the time the invention was made thus rendering the claim obvious.” (Office Action, pg. 8)

It appears that the Examiner is rejecting the claim based upon the rationale set forth in MPEP 2143, Sec. B, which provides the following:

“To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
- (2) a finding that the substituted components and their functions were known in the art;
- (3) a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.”

In the present matter, with regard to the above-identified item (1) of MPEP 2143, the Office Action made a finding that Wilson contained a method which differed from claim 1. In particular, the Action indicated that Wilson differed from claim 1 since it does not teach “identifying a plurality of possible meeting locations based on a parameter,” as required by this claim.

With regard to item (2) of MPEP 2143, the Action goes on to substitute the known element of Wilson (POI category type) with the “identifying” element of claim 1. The Action simply indicates that Applicant’s claimed “identifying” function can somehow be used for the substituting process. Applicant respectfully submits that this is an improper application of the rationale of MPEP 2143, which clearly states that the substituted components and their functions are known in the art. In the present matter, the Action has not demonstrated that the claimed “identifying” feature is known in the art.

Item (3) of MPEP 2143 further supports Applicant’s position, in that there must be a “finding that one of ordinary skill in the art could have substituted one known element for another.” Both of the elements involved in the substitution must be known in order for this item (3) to be met. However, this is not the case in the present Action since the second item involved in the purported substitution (i.e., Applicant’s own claim element) is not well known. Applicant further invites the Examiner’s attention to the four examples listed under MPEP 2143, Sec. B. All of these examples describe the scenario in which the substituted components involve separate references, none of which are the claims of the application undergoing examination.

Applicant understands that the rationale to support a conclusion that a claim would have been obvious is that the substitution of one known element for another yields predictable results to one of ordinary skill in the art. However, if any of the above-identified findings (1) – (4) cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. (MPEP, Sec. B). In the present matter, Applicant has demonstrated that at least findings (1) – (3) are missing from the Office Action. Consequently, claim 1 is not obvious over Wilson.



### **“Selecting a meeting location”**

Claim 1 further recites “selecting a meeting location, from the plurality of possible meeting locations, based on the location of each of the plurality of participants.” Page 7 of the Office Action refers to para. 0039 of the Wilson reference as teaching this function. Applicant respectfully disagrees.

Applicant’s review of the cited portion of Wilson reveals a scheme by which meeting location information is provided to a mobile device. In particular, Wilson provides (1) automatically determining locations of first and second mobile devices; and (2) automatically providing information to at least the first or second mobile device regarding a meeting location.

Claim 1 is distinguishable for at least two reasons. First, the Wilson system is simply “providing information” regarding a meeting location. There is no selecting of this meeting location. Simply identifying a meeting location does not mean that it is selected. Consequently, this passage of Wilson cannot teach or suggest the “selecting a meeting location” feature of claim 1. A second reason is that Wilson merely mentions a singular meeting location. Claim 1 is quite different in that it recites “the plurality of possible meeting locations.” The single meeting location of Wilson clearly does not teach the plural “meeting locations” as required by claim 1.

In summary, Applicant has demonstrated above that several findings necessary to support an obviousness rejection using the rationale set forth in MPEP 2143, Sec. B has not been established. Applicant has further demonstrated that Wilson does not teach at least two features recited in claim 1. Accordingly, claim 1 is believed to be patentable over Wilson. Independent claim 29 includes language similar to that of claim 1, and thus, is believed to be patentable for reasons similar to those discussed with regard to claim 1. The rejected dependent claims 9-17 are believed to be patentable at least by virtue of their respective dependence on claim 1.

### **Dependent claim 6**

Dependent claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson and Perrella, and further in view of Hall.

Claim 6 recites “wherein the selecting the meeting location is based on the mode of transportation for each of the plurality of participants.” Page 11 of the Office Action relies upon the Hall patent to teach this feature.

Applicant’s review of the cited portion of Hall reveals a discussion relating to generating an efficient scheduling for one or two parties. Hall makes clear that this scheduling does not relate to a meeting location, but rather pertains to “dynamically schedules the fleet of vehicles and the customers’ appointment times to realize an efficient operation ...” (Hall col. 1, lines 59-61). The distinction is that Hall relates to scheduling of appointment times, not to a “meeting location” as specifically called for in claim 6. In view of these shortcomings, claim 6 is believed to be patentable over the combination of Wilson, Perrella, and Hall.

### **Independent claim 23**

Page 13 of the Office Action indicated that independent claim 23 is rejected based upon the reasoning set out with regard to claims 1, 2, 8, and 10. Applicant is unable to discern any similarity between claim 10 and claim 23, but believes that the Action intended to identify claim 6, which also recites the “mode of transportation” feature. Applicant finds it difficult to assess the basis of the rejection to this claim, but believes that it is on the basis of 35 U.S.C. § 103(a) using some combination of Wilson, Perrella, Jones, and Hall.

Applicant has set out above comments with regard to claim 6 which demonstrate that Hall fails to teach the “selecting the meeting location” feature. Such comments apply equally to independent claim 23. In view of these shortcomings, claim 23 is believed to be patentable over the combination of Wilson, Perrella, Jones and Hall. In the event this rejection is maintained, Applicant respectfully requests clarification of the basis for this rejection.

Dependent claims 2-5, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Wilson, Perrella, and Jones. Applicant submits that these dependent claims are believed to be patentable at least by virtue of their respective dependence on claim 1.

**CONCLUSION**

In view of the above, Applicant submits that the currently pending claims are in condition for allowance. However, should there remain any outstanding issues, it is respectfully requested that the Examiner telephone the undersigned so that such issues may be resolved as expeditiously as possible.

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